

REMARKS

Reconsideration and allowance of the application are respectfully requested in light of the above amendments and the following remarks.

Claims 1-3 and 16-24 have been amended to place all elements in clear non-means-plus-function format. The amendments are deemed to be non-narrowing; therefore, no estoppel should be considered to attach thereto.

Claims 1-43 stand rejected, under 35 USC §102(e), as being anticipated by Powar (US 6,285,991). The Applicants respectfully traverse these rejections based on the points set forth below.

The Applicants respectfully submit that the Office Action fails to establish a *prima facie* case of anticipation of claims 1-43.

With respect to requirements for establishing a *prima facie* case of unpatentability, the Applicants note the following.

The U.S. Supreme Court in *Graham v. John Deere Co.*, 383 US 1, 148 USPQ 459 (1966), focused on the procedural and evidentiary processes for reaching a conclusion to support a prior art rejection. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). As adapted to *ex parte* procedure, *Graham* is interpreted as continuing to place the burden of proof on the Patent Office to produce the factual basis for its rejection of an application

under sections 102 and 103. *Id.* at 1472; and *In re Warner*, 379 F.2d 1011, 1016 (CCPA 1967). Only after a *prima facie* case of unpatentability has been established, does the burden of going forward shift to the applicant. *Id.* at 1472.

To establish a *prima facie* case of anticipation, the Office is required to set forth in a rejection the specific findings of fact and conclusions of law adequate to form a basis for review by a court. See *Getchter v. Davidson*, 116 F.3d 1454, 1460 (Fed. Cir. 1997). In particular, the Office's anticipation analysis must be conducted on a limitation-by-limitation basis, with specific fact findings for each contested limitation and satisfactory explanations for such findings. *Id.* at 1460; and see *In re Fine* 837 F.2d 1071, 1074 (Fed. Cir. 1988).

The Administrative Procedure Act requires the Office to present a full and reasoned explanation of its decision to reject an applicant's claims. *In re Lee*, 277 F.3d 1338, 1342 (Fed. Cir. 2002). The Office must set forth its findings and the grounds thereof, as supported by the record, and explain its application of the law to the found facts. *Id.* at 1342. In brief, the Office action must communicate its findings and conclusions and articulate by reasoned explanation how the conclusions are supported by the findings. see MPEP §2144.08 III, last sentence of first paragraph.

Accordingly, it is well settled that to establish a *prima facie* case of unpatentability, the Office must communicate its findings of fact and conclusions and articulate how the conclusions are supported by the findings of fact (see MPEP §2144.08 III, last sentence of first paragraph). The Office Action provides no findings of fact whatsoever; instead, the Office Action merely recites the subject matter of each claim verbatim and then concludes that Powar discloses this subject matter somewhere within eleven columns of the specification (i.e., nearly the entire description of Powar's invention). For example, claim 1 recites three elements - a financial services server, a client, and a point of sales terminal. The Office Action provides no findings of fact as to how Powar discloses these three elements (see Office Action section 2, second paragraph). Similar reasoning applies to independent claim 26, which is a method claim corresponding to the system defined by claim 1, and the claims depending from claims 1 and 26.

Additionally, to support a *prima facie* case of unpatentability, the Office's findings of fact must clearly articulate which portions of the applied reference support a rejection (MPEP §2144.08 III, first sentence of second paragraph). As discussed above, the Office Action cites nearly the entire description of Powar's patent. This cannot reasonably

be construed as a clear articulation of the portions of the applied references that disclose the three above-mentioned elements recited in claim 1, for example, or the individual additional elements recited in numerous ones of the claims depending from claim 1. Similar reasoning applies to claim 26 and its dependent claims.

Furthermore, conclusory statements of similarity, without any articulated rationale or evidentiary support, do not constitute sufficient factual findings to support a *prima facie* case of unpatentability (see MPEP 2144.08 III, last sentence of second paragraph). As stated above, the Office Action merely recites the subject matter of each claim verbatim and concludes that Powar discloses the claimed subject matter, without articulating any rationale or evidentiary support for the conclusion.

Thus, for each of three above-mentioned reasons, the Office Action fails to establish a *prima facie* case of unpatentability for any claim. Therefore, allowance of claims 1-43 is warranted.

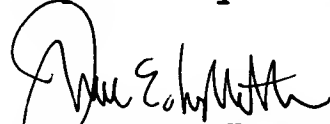
Given the failure to establish a *prima facie* basis for the rejections, the burden of persuasion does not lie with the Applicants to distinguish the claims from the applied references. Nevertheless, the Applicants provide the following remarks to expedite allowance of the application.

Independent claims 1 and 26 recite a financial services server that provides remotely configurable preferences for a customer account through a communication network. Powar does not disclose this subject matter. Powar merely discloses, in relation to the claimed feature, that a customer may receive billing information via a communication network (see Powar col. 5, lines 1-2 and 18-21).

Accordingly, it is submitted that claims 1 and 26 are not anticipated by Powar. Therefore, allowance of claims 1 and 26 and all claims dependent therefrom is warranted for this independent reason.

In view of the above, it is submitted that this application is in condition for allowance and a notice to that effect is respectfully solicited.

Respectfully submitted,



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